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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,677	09/29/2005	Thomas W Haines	12056.001	5990

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EXAMINER	
MCAVOY, ELLEN M	

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
02/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,677	HAINES ET AL.	
	Examiner	Art Unit	
	Ellen M. McAvoy	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Specification

The use of the trademark PROWAX ™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claims 5 and 6, and independent claim 7, use the trade name PROWAX to identify the first and second petroleum hydrocarbon components which renders the claims indefinite because the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd.App. 1931).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al (5,498,353).

Lin et al ["Lin"] disclose a semi-synthetic two-stroke engine oil formulation which comprises a base oil consisting of a high viscosity mineral oil in an amount of 0-20% by weight; a medium viscosity mineral oil in an amount of 10-50% by weight; a solvent in an amount of 5-30% by weight; and a mixture of other additives including three polyisobutylenes with different molecular weights, detergents and dispersants. See column 2, lines 12-59. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the claimed lubricant formulation. Lin teaches that the engine oil formulation may be prepared by mixing. See column 3, lines 14-27. Lin teaches that the high viscosity mineral oil is a paraffiic based oil having a viscosity of about 10-15 cSt at 100°C. The examiner is of the position that the high viscosity mineral oil component of Lin meets the limitations of the second petroleum hydrocarbon component of the claims which is a paraffin having a viscosity greater than 16 cSt at 100°C since the viscosity of "about 15 cSt" of the reference does not differ from "greater than 16 cSt" of the claims. Lin teaches that the medium viscosity mineral oil is also a paraffinic based mineral oil which has a viscosity of about 4-8 cSt at 100°C which meets the limitations of the claimed first petroleum hydrocarbon component. Thus the

examiner is of the position that the engine oil formulation of Lin appears to meet the limitations of the claimed lubricant formulation and the claimed method of preparing the lubricant formulation by mixing the components. Applicants' invention may differ in dependent claims 2 and 8 wherein the hydrocarbon solvent is about 55 % by weight of the total formulation which differs from the solvent amount of about 5-30% by weight in the prior art formulation. However, the examiner is of the position that it would have been obvious to the skilled artisan to have increased the amount of inert solvent in the lubricant formulation if a more diluted lubricant formulation was so desired.

Claim Rejections - 35 USC § 103

Claims 1-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al (4,983,313).

Kaneko et al ["Kaneko"] disclose a refrigerating machine oil composition comprising (A) 85 to 30% by weight of alkyl benzene as a solvent, (B) 5 to 70% by weight of a paraffin based mineral oil having a kinematic viscosity at 40°C of 20-500 cSt and (C) 1 to 30 % by weight of a naphthene-based mineral oil having a kinematic viscosity at 40°C of 5 to 500 cSt. See column 1, lines 37-62. Kaneko teaches that the oil composition is obtained by blending the above components. See column 3, lines 47-61. Although the viscosities of mineral oil components (B) and (C) are measured at 40°C and not at 100°C as claimed, the examiner is of the position that the wide range of viscosity values of the prior art mineral oils encompass the claimed viscosity values. Thus the examiner is of the position that the oil compositions of Kaneko appear to meet the limitations of the above rejected claims which "comprise" a solvent and two petroleum

hydrocarbons of different viscosities. The recitation "a surface protective formulation having anti-corrosive capabilities" in independent claims 1, 7 and 11 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al (5,498,353) or Kaneko et al (4,983,313) in combination with Dituro et al (6,919,300).

Lin and Kaneko are relied on as outlined above. Dependent claim 12 differs when the lubricant formulation is placed under pressure for aerosol application. However, as evidenced by Dituro et al, lubricant compositions containing a major amount of mineral oil may be combined with solvents such as mineral spirits and propellants to make a sprayable composition. See the claims. Thus having the prior art references before the inventors at the time the invention was made it would have been obvious to have formed an aerosol of the lubricant formulations of Lin and Kaneko if a sprayable composition was so desired.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/
Primary Examiner
Art Unit 1797

EMcAvoy
January 29, 2009